

REMARKS

Claims 19-24, 27-46 and 49-64 are pending in the application.

1. AMENDMENTS TO THE CLAIMS

With this amendment claims 19, 20, 23, 24, 27, 28, 30-36, 40, 42 and 43 are amended without altering their scope to clarify that in the compounds recited at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen. Applicants submit that the canceled claim language regarding R^{4'}, R^{5'}, R^{6'}, R^{7'} was redundant with the remaining claim language regarding R^{4'}, R^{5'}, R^{6'}, R^{7'}. Claims 24 and 27 have also been amended to correct a typographical error. Applicants submit that the amendments to the claims are fully supported by the specification and claims as originally filed and respectfully request entry thereof.

Applicants reserve the right to prosecute any canceled subject matter in one or more continuing applications.

2. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

The Patent and Trademark Office (PTO) has maintained the rejection of claims 19-24, 27-46 and 49-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,527,819 to Williams *et al.*, hereinafter, "Williams." The PTO alleges that the substitution pattern of Williams *et al.* encompasses the substitution patterns of formula (I) as presently claimed.

Applicants respectfully request that the PTO reconsider the outstanding rejection in view of the clarifying amendments to the claims. In the compounds administered in the claimed methods, at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen. In contrast, in Williams *et al.*, as noted by the PTO, does not teach that any of R^{4'}, R^{6'} or R^{7'} can be anything other than hydrogen. As such, in view of the clarifying amendment to the claims, Williams *et al.* in formula A does not encompass the compounds or substitution pattern of formula (I) as presently claimed in claims 27-46 and 49-56.

Applicants further respond to specific arguments made by the PTO. The PTO indicates that formula (I) of claim 1 is not limited to any substitution pattern or functional group as presently claimed. Applicants respectfully note that claim 1 is canceled.

The PTO indicates that claim 19 includes alternative embodiments, in particular at R^{4'}, R^{5'}, R^{6'} and R^{7'}. Applicants have clarified with the present amendments to the claims that at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen in claim 19. Further, applicants note that prior to the present amendments, the two alternatives in claim 19 cited by the PTO did not overlap with formula A of Williams *et al.* since at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} were not hydrogen in either alternative of claim 19 as previously pending. Nevertheless, Applicants have amended claim 19 to clarify the scope of R^{4'}, R^{5'}, R^{6'}, and R^{7'}.

Finally, the PTO alleges that the rejection over Williams *et al.* is not based solely on the reasoning of *In re Heinze*. However, if the reasoning based on *In re Heinze* is removed from the outstanding rejection, there remains no reason alleged by the PTO to modify the compounds of Williams *et al.* to arrive at the claimed compounds. Applicants remind the PTO that the U.S. Supreme Court has emphasized the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007). The Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” 127 S. Ct. at 1741. Indeed, the recent PTO guidelines have stated that “the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” *See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, Federal Register 72(105), 57526-57535, 57528, 3rd col., 3rd paragraph.

In view of the foregoing, Applicants respectfully request the rejection of claims 19-24, 27-46 and 49-56 in view of Williams under 35 U.S.C. § 103(a) be withdrawn.


CONCLUSION

In light of the above remarks, Applicants respectfully request that the Patent Office reconsider this application with a view towards allowance. Applicants submit that the pending claims satisfy all of the criteria for patentability and are in condition for allowance.

Pursuant to 37 C.F.R. §1.136 (a)(3), the Commissioner is authorized to charge all required fees, or credit any overpayment, to Jones Day Deposit Account No. 50-3013 (order no. 417451-999076).

Respectfully submitted,

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